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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,867	10/14/2003	Frederic Guerin	PO-7962/PS-1127	4807
34947	7590	05/24/2006	EXAMINER	
LANXESS CORPORATION 111 RIDC PARK WEST DRIVE PITTSBURGH, PA 15275-1112			RONESI, VICKEY M	
			ART UNIT	PAPER NUMBER
			1714	
DATE MAILED: 05/24/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/684,867

Applicant(s)

GUERIN, FREDERIC

Examiner

Vickey Ronesi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/13/2006 has been entered.
2. The amendment filed 3/13/2006 includes non-compliant markings in claims 5-8. Note that double-bracketing indicates deletion and not insertion of claim language. To insert language into a claim, underlining is required. Appropriate correction is required.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
4. All outstanding rejections, unless given below, are withdrawn in light of applicant's amendment filed 3/13/2006.

Specification

5. The disclosure is objected to because of the following informalities: on page 8, "Formula VI" should be read as "Formula IV" since it is the fourth formula.

Appropriate correction is required.

Claim Objections

6. Claim 1 is objected to because of the following reasons:

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- In line 5, the word “prepare” should be replaced with “prepared.”
- In line 29, “a anionic ligand” should be replaced with “an anionic ligand.”
- In line 30, the term “they” should read as “it” since there is only one L² ligand.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, the phrase “such as” in line 17 and the 4th to last line of the claim renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

With respect to claims 2-9, they are rejected for being dependent on a rejected claim.

Double Patenting

Five obviousness-type double patenting rejections are set forth below.

Double Patenting, I

8. Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-14, 16, and 7 of copending Application No. 10/728,029.

The discussion in paragraph 13 of Office action mailed 9/14/2005 is incorporated here by reference.

While US '029 does not claim a polymer composite comprising a nitrile rubber prepared with a metathesis catalyst, the presently claimed metathesis catalyst are taught on page 5, line 10 to page 8, line 4 of US '029's specification. Case law holds that those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970).

Applicant's statement on page 11 of the amendment filed 3/13/2006 regarding the provisional obviousness-type double patenting rejection is acknowledged. If this double-patenting rejection is the only rejection remaining in this application and if there is a provisional obviousness-type double patenting rejection in the later-filed copending application, per USPTO practice, the examiner will withdraw the rejection.

Double Patenting, II

9. Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/684,601.

The rejection is adequately set forth in paragraph 14 of Office action mailed 9/14/2005 and is incorporated here by reference.

Applicant's statement on page 12 of the amendment filed 3/13/2006 regarding the provisional obviousness-type double patenting rejection is acknowledged. If this double-patenting rejection is the only rejection remaining in this application and if there is a provisional obviousness-type double patenting rejection in the later-filed copending application, per USPTO practice, the examiner will withdraw the rejection.

Double Patenting, III

10. Claims 1-3 and 5 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,780,939 alone or in view of Oyama et al (US 5,651,995). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

US '939 claims a shaped article of a composition comprising a hydrogenated nitrile rubber having a Mooney viscosity of 3-50 and a polydispersity index of less than 2.5

US '939 does not claim that the nitrile rubber is prepared by the presently claimed metathesis catalysts, however, note col. 4, line 23 to col. 5, line 59 where US '939 teaches the use of metathesis to obtain the hydrogenated nitrile rubber. Case law holds that those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970).

While '939 does not disclose a filler, given that it is used in shaped articles which conventionally utilize a filler, it would have been obvious to one of ordinary skill in the art to add a filler to the composition of US '939. Evidence to support the examiner's position is found in Oyama et al which discloses gaskets, seals, belts, etc (col. 33, lines 16-38) and teaches the use of fillers in such articles (col. 13, lines 47-53).

11. Claims 1-3 and 5 are directed to an invention not patentably distinct from claim 2 of commonly assigned U.S. Patent No. 6,780,939. Specifically, see the discussion set forth in paragraph 10 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent No. 6,780,939, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

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12. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,780,939 in view of Oyama et al (US 5,651,995). See the discussion set forth in paragraph 10 above.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Double Patenting, IV

13. Claims 1-3 and 5-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6-8, 10, 11, and 13 of copending Application No. 10/685,232 (published as US 2004/0127647) alone or in view of Oyama et al

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(US 5,651,995). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

US appl. '232 claims a polymer blend comprising a nitrile rubber polymer having a Mooney viscosity below 10 and a process of making a shaped article by injection molding.

While US appl. '232 does not claim the polydispersity of the nitrile rubber or that the nitrile rubber is prepared with specific metathesis catalysts; see page 6, lines 13-17 where US appl. '232 discloses a polydispersity of less than 3 and page 7, line 1 to page 9, line 19 for the preferred metathesis catalysts of its invention. Case law holds that those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970).

Regarding the addition of fillers, note page 14, line 9 to page 16, line 8 for fillers used in US appl. '232's blend. Alternatively, given that the blend of US appl. '232 is used in shaped articles which conventionally utilize a filler, it would have been obvious to one of ordinary skill in the art to add a filler to the composition of US '939. Evidence to support the examiner's position is found in Oyama et al which discloses gaskets, seals, belts, etc (col. 33, lines 16-38) and teaches the use of fillers in such articles (col. 13, lines 47-53).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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14. Claims 1-3 and 5-9 are directed to an invention not patentably distinct from claims 1-3, 6-8, 10, 11, and 13 of commonly assigned copending Application No. 10/685,232 (published as US 2004/0127647). Specifically, see the discussion set forth in paragraph 13 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned copending Application No. 10/685,232 (published as US 2004/0127647), discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Double Patenting, V

15. Claims 1-5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No.

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10/726,379 (published as US 2004/0132906). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

US appl. '379 claims a composition comprising a nitrile rubber having a Mooney viscosity below 30, optionally at least one filler, optionally at least one cross-linking agent, and a curing system.

While appl. '379 does not claim the polydispersity of the nitrile polymer or that the nitrile rubber is prepared with specific metathesis catalysts; see page 6, lines 1-6 where US appl. '232 discloses a polydispersity of less than 3 and page 6, line 16 to page 9, line 8 for the preferred metathesis catalysts of its invention. Case law holds that those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970).

Given that US appl. '379 teaches polydispersity and metathesis catalysts like presently claimed, it would have been obvious to one of ordinary skill in the art to obtain the present invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claims 1-5 are directed to an invention not patentably distinct from claims 1-5 of commonly assigned copending Application No. 10/726,379 (published as US 2004/0132906). Specifically, see the discussion set forth in paragraph 15 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned copending Application No. 10/726,379 (published as US 2004/0132906), discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5/22/2006

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